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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,999	08/20/2001	Frank-Rainer Bohm	FA-1022	8379
7590 01/05/2004 E I du Pont de Nemours & Company Legal Patents Wilmington, DE 19898			EXAMINER BISSETT, MELANIE D	
			ART UNIT 1711	PAPER NUMBER
DATE MAILED: 01/05/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/913,999	Applicant(s) BOHM ET AL.	
	Examiner Melanie D. Bissett	Art Unit 1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☒ All b) ☐ Some * c) ☐ None of:
 1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

1. The request filed on 10/17/03 for Continued Examination under 37 CFR 1.114 based on parent Application No. 09/913,999 is acceptable and an RCE has been established. An action on the RCE follows.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 13-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Claim 13 recites "conventional binder" and "conventional additive, solvent, pigment, and/or filler". It is unclear which components should be included in "conventional binder" or "conventional additive, solvent, pigment, and/or filler". Thus, the claims are rendered indefinite by the use of such terms.

5. Also, claim 13 recites "1-60 wt.%", "0-90 wt.%" and "0-95 wt.5" but does not specify the whole of which each component comprises a percentage. On what are the percentages based? For example, it is unclear whether the components comprise a percentage of the coating composition or of the total of only (A), (B), and (C). For the purpose of this Office action, the examiner interprets the limitations as percentages of the whole coating composition.

Claim Rejections - 35 USC § 102

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 13, 15-19, and 25-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Vassiliou as evidenced by Majumdar et al. and *Hawley's Condensed Chemical Dictionary*.

8. From a prior Office action:

Vassiliou discloses a coating composition comprising a colloidal silica, a fluorocarbon polymer, and a number of additives (col. 1 lines 59-63). The reference prefers the use of Ludox AM (col. 2 lines 30-47), noted by Majumdar as a silica modified to contain hydroxyl groups (col. 5 lines 36-43). Preferred particle sizes range from 7 to 25 millimicrons. Composition A shows ~31 wt.% colloidal silica, ~46 wt.% of polymer binder dispersion, and ~23 wt.% of additives or solvents. From the discussion of surface modification of Ludox AM silica particles in Majumdar et al., it is the examiner's position that one of ordinary skill in the art would clearly envision the hydroxyl groups being present in the applicant's broad range of "up to 98 wt.%". The coatings of Vassiliou's invention are intended for metal substrates, thus providing coating compositions for electrically conductive substrates.

Claims 15-16 limit R₃ and R₄, respectively, without limiting the reactive particles to contain additional radicals R₃ and R₄. Since the silica particles of the reference do not seem to have additional functionality, R₃ and R₄ would not be present, and the further limitations of each additional radical provide no patentable weight over the prior art. In other words, the reference anticipates the claims since the radicals specified are not present.

Additionally, Vassiliou teaches the addition of a silicone resin as an anti-mudcracking agent, thus anticipating the applicant's claim 19 (col. 3 lines 58-61; examples).

9. Regarding the newly added limitations that the presence of a binder component B is required, note that Vassiliou teaches the presence of a fluorocarbon binder.

Regarding the limitation that the coating have electrically insulating properties, note that this is a broad term. Thus, a coating having any amount of insulative property would be encompassed. *Hawley's Condensed Chemical Dictionary* teaches that PTFE provides

"excellent resistance to electricity" (p. 906) and that Teflon is used for electrical insulation (p. 1076). Thus, it is the examiner's position that the coating composition of Vassiliou's invention, preferably based on PTFE binder materials (col. 2 lines 3-12), would inherently possess a degree of electrical insulation.

Double Patenting

10. Claims 13-26 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-13 of copending Application No. 10/032,858. Although the conflicting claims are not identical, they are not patentably distinct from each other because of the substantial overlap in claimed subject matter. The copending claims require 1-90 wt. % of a binder, corresponding to presently claim component B. Also, the amount of reactive particles is lesser (0.3-25 wt. %) in the copending application. However, both claims cover 1-90% binder and 0.3-25% reactive particle. Since at least 1% of binder is required in the copending application, the new limitation in claim 13 is met. Also, because the materials are the same in both applications, it is the examiner's position that the copending coatings would inherently possess the presently claimed electrically insulative properties. Copending claims 2-13 parallel present claims 14-26. Thus, because of the substantial overlap of coverage between the two applications, the inventions are not patentably distinct.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

11. In response to the arguments that Majumdar teaches away from an electrically insulative coating, the rejection using Majumdar as a primary reference has been withdrawn.

12. Regarding the applicant's arguments that the coating of Vassiliou would be heat conductive and thus not electrically insulative, it is noted that heat conduction and electrical conduction require different circumstances. They are not equivalent. In this case, Vassiliou prefers the use of PTFE coating materials. The examiner has pointed to a teaching showing that such materials are conventionally known as electrically insulative materials. Thus, the coatings of Vassiliou inherently possess a degree of electrical insulation.

13. In response to the applicant's argument that the fluorocarbon materials of Vassiliou do not form an inorganic-organic-oxygen network or otherwise react with the reactive particles, it is noted that the claims do not require such a limitation. The claims simply state that a binder must be present in certain circumstances. The formation of an inorganic-organic-oxygen network is not required, and the reaction between the reactive particles and the binder is not required. Vassiliou therefore anticipates the claims.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (571) 272-1068. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

mdb


RABON SERGENT
PRIMARY EXAMINER